

Application No. 10/749,164

REMARKS

Claims 1-14 and 23-26 are pending. By this Amendment, claims 1, 8 and 23 are amended. The amendments to claims 1, 8 and 23 are supported by, for example, originally filed claims 2, 9 and 24. No new matter is introduced by the present amendment

In the Office Action, the Examiner objected to claims 2, 9 and 24, asserting that those claims permit R₁₀-R₁₂ to be part of a cyclic ring group, but the base claim provides no such definition for the corresponding structure. Applicants have amended independent claims 1, 8 and 23 to recite that the Y group can comprise part of a cyclic group. As such, claims 2, 9 and 24 are not broader in scope than the respective base claims, and Applicants respectfully request the withdrawal of the objection to claims 2, 9 and 24.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-3, 5-10, 12-14 and 23-25 under 35 U.S.C. § 112, first paragraph, asserting that the specification does not reasonably provide enablement for the term part of a ring group. More specifically, the Examiner asserted that, "[t]here is no disclosure in the specification of how to make a part of a cyclic ring group." Applicants submit that the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims. Applicants respectfully request reconsideration of the rejection based on the following comments.

Applicants submit that one of ordinary skill in the art would understand that part of a cyclic ring group is an atom or group that is bonded to other atoms or groups in a ring system. As such, the terminology is being used to indicate that the claims include groups where, for example, two R groups are connected to form a cyclic group, as depicted in compounds (5) and (6) on page 23 of the specification. The specification describes the synthesis of compounds (5) and (6) on pages 27 and 28, and therefore the specification discloses how to prepare charge

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transport materials where desired R groups form part of a cyclic group. Moreover, one of ordinary skill in the art could prepare numerous additional compounds having R groups that form part of a cyclic ring group based upon the disclosed compounds and corresponding synthetic methodologies. Thus, Applicants submit that the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims.

Since the specification enables one of ordinary skill in the art to make and use the invention commensurate with the scope of the claims, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 5-10, 12-14 and 23-25 under 35 U.S.C. § 112, first paragraph.

Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-3, 5-10, 12-14 and 23-25 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserted that the definition of the R groups as part of a cyclic ring is indefinite because "such an incomplete structure does not particularly point out and distinctly claim the invention because it is unclear how a partial structure defines, with the other components, a charge transport compound. Applicants submit that the term part of a cyclic ring is definite, and respectfully request reconsideration of the rejection based on the following remarks.

"The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" See MPEP § 2173.02 (quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081, 1088 (Fed.Cir 1986)). As discussed above, one of ordinary skill in the art would understand that "part of cyclic group" refers to an atom or group that is bonded to other atoms or groups in a ring or cyclic system. For example, a carbon atom in a benzyl group is part of cyclic group. Moreover, this terminology is being used to describe the situation where, for

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example, two R groups are connected to form a cyclic group. In this situation, each R group forms part of the cyclic ring group. Specifically, as discussed above, compounds (5) and (6) depict a charge transport material wherein an R group forms part of a cyclic group. Since one of ordinary skill in the art would understand what "part of cyclic group" means, the term "part of a cyclic group" is definite.

Since the term "part of cyclic group" is definite, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 5-10, 12-14 and 23-25 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 23-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Application 2004/0170910 (the '910 application). Additionally, the Examiner asserted that "the instant application has the same filing date as Tokarski and that each application claims domestic priority under § 119(e)." The Examiner further asserted that the '910 application is prior art under § 102(e) because, "the above rejected claims are not entitled to the earlier filing date of the § 119(e) priority claim." Applicants submit that the '910 application is clearly based upon Applicants' own work, and respectfully request reconsideration of the rejection based on the following comments.

The '910 application is only potentially prior art with respect to the present application with respect to the disclosure in the provisional to which that application claims priority since the '910 application itself has the same filing date as the present application. On the present facts, prior invention by the present Applicants as well as derivation by the inventors of the '910 application are perfectly clear on the documentary evidence in front of us. Whether or not the

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provisional to which the present application claims priority can support the present claims, the filing of the provisional provides a **date certain** for the invention of the subject matter in that application by the present inventors.

The provisional application to which the present application claims priority discloses epoxy terminated compositions that provide the basis for the dimers disclosed in the '910 application. While the dimers are inventive in their own right, clearly the dimers could not be synthesized until the epoxy terminated compounds of the instant application were obtained. Since the present inventors invented the epoxy terminated compounds, as evidenced by the provisional under the present priority claim, the dimers are unambiguously derivative work. Also, the epoxy groups disclosed in the '910 application is not prior to the provisional to which the present application claims priority, so there is documentary evidence that the '910 filing is not prior to invention of the relevant invention by the present inventors. Since this evidence and its date certain are the subject of a legal filing in the patent office, an affidavit confirming this is clearly not necessary since the affidavit would only say what is already in evidence. Therefore, the evidence of record in the patent office and the corresponding dates certain, demonstrates that the '910 filing date was not prior to the relevant species of the present invention. Therefore, no affidavit is required in view of the evidence of record in the patent office.

In summary, the dimer compounds disclosed in the '910 application are based upon, or formed from, the epoxy terminated compounds disclosed in the provisional application claimed in the present application. The provisional application claimed in the present application was filed on January 31, 2003, and predates the effective filing date of the '910 application. As such, it is clear that compounds disclosed in the '910 application are based on the work disclosed in the provisional application filed on January 31, 2003. In other words, the disclosure of the '910 application is derivative of Applicants' own work and postdates the corresponding work of Applicants, and therefore is not a proper 102(e) reference.

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Since the disclosure of the '910 application is clearly based upon Applicants' own work, as evidence by the provisional application filed on January 31, 2003, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Application 2004/0170910.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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